

REMARKS

The Office Action dated November 14, 2003 in the above-identified patent application has been carefully considered. In the Office Action, claims 7, 8 and 13-16 have been allowed; claims 2-6 and 9-12 have been withdrawn from consideration; and only claim 1 has been rejected over the prior art of record. By way of this amendment, claims 17-20 have been added to even further differentiate the prior art. Claims 1-20 remain in the present patent application. Applicant respectfully requests reexamination and reconsideration of the rejection in view of the following remarks.

Turning to the only rejection, claim 1 has been rejected as obvious over Alcok et al. in view of Hasler et al. This obviousness rejection is respectfully traversed. It is respectfully submitted that the rejection is being made with the improper use of hindsight. Specifically, the Federal Circuit has held that "defining the problem in terms of its solution reveals improper hindsight in the selection of the prior art relevant to obviousness." *Monarch Knitting Machine Corporation v. Sulzer morat GmbH*, 45 USPQ2d 1977, 1981 (Fed. Cir. 1998); see also *Ecolochem v. Southern California Edison Co.*, 56 USPQ 2d 1065 (Fed. Cir. 2000); and *In re Rouffet*, 47 USPQ 2d 1453 (Fed. Cir. 1998).

The cases cited above and the application of hindsight is particularly applicable here since the secondary reference Halser et al. does not deal with solving the problems faced with rod cutting machines that cut relatively hard and rigid material. In particular, if only speed of operation was of concern as contended in the Office Action, the obvious solution in the specific art as applied to rod cutting machines would be to eliminate the closed knife and make the knife open wiht a slot as shown for example in the prior art figures of FIGS. 1-4 of the present patent application. Indeed, "most conventional prior rod cutting machines are equipped with an open knife for cutting rod stock into shorter rods". See page 2, paragraph 3 of the present patent application. Thus, if speed was the only issue as is contended by the Patent Examiner as cited in the Office Action, one skilled in the art would be motivated to move toward an open knife type arrangement without any type of ejection system.

However, the present invention relates to precision operations when it is desirable to reduce the distortion of the rod during a shearing operation and potential jamming that may result and potential lodging of the cut rod in the closed knife. See pg. 6, ln. 20-pg. 7, ln. 10 of the present patent application. Accordingly, in such prior art closed knife systems, as opposed to open knife systems, a mechanical ejection actuating mechanism is typically provided. See lns. 14-20 at page 6 of the present application. However, one significant problem is cost and complexity with mechanical ejection mechanisms. See pg. 7, lns. 22-25.

The Hasler et al. reference has nothing to do with solving the problems relating to jamming and lodging, nor is there any evidence that such mechanical ejection apparatus is ever used in such a "yarn cutting device" as taught by Hasler et al. Indeed, such mechanical ejection apparatus would not seem to be used in association with non-rigid material such as yarn. Furthermore, under Hasler et al. that there can be no lodging or jamming problems since as shown in the figures, there is plenty of clearance between any such openings and the highly flexible and non-rigid yarn material.

Accordingly, since Hasler et al. does not relate to the problems faced by the inventors, it is respectfully submitted that the obviousness rejections are being made with the improper use of hindsight using the Applicant's teachings relating to eliminating such mechanical ejection apparatus in prior art closed knife systems. Accordingly, Applicant respectfully requests that the Patent Examiner withdraw the obviousness rejections that have been advanced against claim 1 and reinstate the appropriate withdrawn claims (an interview between Applicant and the Patent Examiner in this regard or any other regard may be worthwhile to move this matter forward), so that the application can move toward a Notice of Allowance.

Additionally, it should be noted that new claims 17-20 have been added to set forth structural distinctions which are not disclosed in the combination of Alcok et al. and Hasler et al. Specifically, in contrast to claim 17, Hasler et al. teaches to discharge at at least $22\frac{1}{2}$ degrees relative to the axis and not generally parallel to the axis as claimed. In contrast to claim 18, the imported discharge port of Hasler et al. is arranged above the axis, not below the axis and the gage surface as claimed. In contrast to claim 19, the asserted discharge port of Hasler et al. is the same size in area as the opening in the knife as shown in the figures, which is clearly not of a different size as claimed in claim 19, and shown for example in FIGS. 9-16. Finally, claim 20 is differentiated since there is no secondary mechanical abutment means for ejecting rods when the air supply fails to eject the cut rod. This emphasizes the point that there is no lodging or dislodging problems in the secondary reference Hasler et al.

If the Patent Examiner would like to discuss any of the issues raised above or believes that the matter could be moved forward toward a Notice of Allowance, the Applicant would respectfully invite a telephonic interview.

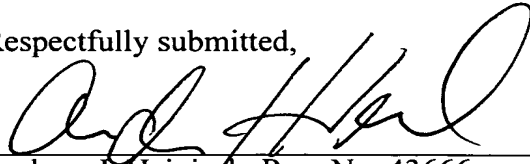
Conclusion

The application is considered in good and proper form for allowance, and the Examiner is respectfully requested to pass this application to issue. If, in the opinion of the

In re Appln. of Bryan Hulstedt
Application No. 09/667,971

Examiner, a telephone conference would expedite the prosecution of the subject application,
the Examiner is invited to call the undersigned attorney.

Respectfully submitted,



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